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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,314	03/01/2002	Claude Zeller	F-417	2091

919 7590 07/26/2005

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EXAMINER

BHATNAGAR, ANAND P

ART UNIT PAPER NUMBER

2623

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/087,314

Applicant(s)

ZELLER ET AL.

Examiner

Anand Bhatnagar

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04/28/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/03/05</u> . | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

1. Applicant's amendment filed on 04/28/05 has been entered and made of record.
2. Applicant has canceled claim 2, but has incorporated the limitation of claim 2 into claim 1. Applicant has amended claim 1, 4, 6, and 7. Currently claims 1 and 3-7 are pending.
3. Applicant in essence argues that the prior art of Rhoads et al. (U.S. pat. Pub. 2004/190751 A1) does not teach the feature of embedding an image of a postal indicia. Applicant is correct but this feature was shown in the prior art of Hayashi et al. (U.S. patent 5,829,895) as was shown by the examiner in the previous office action as well as below in the current action. Applicant further argues that there is no motivation to combine the prior art of Hayashi et al. to that of Rhoads et al. Examiner disagrees. The prior art of Rhoads et al. discloses to embed watermark into a image and wherein images are usually graphic images and is read as such. Therefore since Hayashi teaches to embed data into a postal indicia which is a type of graphic then one skilled in the art would have been motivated to combine the teachings. Further, applicant argues that the prior art Hayashi et al. was "assigned to Pitney Bowes Inc., at the time of the invention of the present application, were commonly owned by or subject to an obligation of assignment to the same entity, namely Pitney Bowes Inc. Thus, U.S. patent No. 5,829,895 should be removed as a reference under 35 USC 103(c.) for the present invention." The prior art of Hayashi et al., though owned by the same

entity as the present instant application, does not fall under 35 USC 103(c.) since this is not a 35USC 102(e) reference and is a 35USC 102(b) reference since this prior art of Hayashi et al. was patented, Nov. 3, 1998, which is more than one year prior to the filing date, March 01, 2002, of applicant's instant invention making this prior art a 35 USC 102(b) reference. A 35 USC 102(b) reference may be used against any inventor(s) and/or assignee(s) as well as the same inventor(s) and/or the same assignee(s).

Applicant has amended original claim 1 with the limitation of original claim 2 making this newly amended claim 1 more narrow then the original claim 1 and also is also more narrow then the present claim 3, which depends from claim 1, causing a new 35 USC 112 issue wherein a dependent claim is broader than the claim it depends from since a postal indicia is a type of graphic. Examiner refers to the rejection below.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte*

*Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 3 recites the broad recitation wherein the image is a graphic, and the claim also recites an image of an postal indicia, i.e. a type of graphic, which is the narrower statement of the range/limitation.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

A.) Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being obvious over Rhoads et al. (U.S. patent pub. 2004/0190751 A1) and Hayashi et al. (U.S. patent 5,829,895).

Regarding claim 1: A method for embedding information in an image so that the image will have different information when the image is reproduced by a

scanning or printing process (paragraphs 0008 and 0009), the method comprising the steps of:

embedding digital information in an image (fig. 1 element 10 and paragraphs 0010 and 0039;

printing the embedded digital information and the image to produce a original printed image (fig. 1 elements 10, 12, and 13, paragraphs 0010 and 0042);

scanning the original printed image to obtain a digital image of the embedded information and the image (fig. 1 element 10B and paragraph 0042, wherein the printed image that contains the watermark(s) is copied, i.e. scanned);

determining the signal strength of the original image (paragraph 0010, wherein the energy level is read as the signal strength); and

comparing the signal strength of a printed image with the signal strength of the original printed image to determine whether or not the printed image is a copy of the original printed image (paragraph 0010, wherein the energy level is read as the signal strength).

Rhoads et al. discloses to embed a watermark into an image and based on energy levels determine if the watermarked image is an original printed image or a copy of the original printed image. Rhoads does not disclose wherein the image is a postal indicia. Hayashi et al. teaches to embed a watermark into a postal indicia (Hayashi et al.; col. 2 lines 63-67, col. 3 lines 1-1-8, and col. 7 lines

35-38). It would have been obvious to one skilled in the art to combine the teaching of Hayashi et al. into the system of Rhoads et al. because they are analogous in watermarking. One in the art would have been motivated to incorporate the teaching of Hayashi et al. into the system of Rhoads et al. in order to mark a postal indicia in order to be able to identify if it is an original postal indicia or a counterfeit.

Regarding claim 4: The method wherein a bit map file is created for the original printed image (paragraph 0010, wherein bit patterns, read as bit map file, are used for the watermarking).

Regarding claim 5: The method wherein the comparing step further including the step of:

measuring the signal strength of the original printed image to set a threshold value for the original printed image and copies of the original printed image (paragraph 0010, wherein the energy level is used to differentiate between a original print or a copy of the original print. In order to different this there inherently has to be a threshold level set which defines an original print or a copy of the original print).

Regarding claim 6: The method whereby if the signal strength of a printed image is greater than the threshold value the printed image is the original printed image (paragraph 0010, wherein the energy level is used to differentiate between a original print or a copy of the original print. In order to different this there

inherently has to be a threshold level set which defines an original print or a copy of the original print).

Regarding claim 7: The method whereby if the signal strength of a printed image is less than the threshold value the printed image is not the original printed image (paragraph 0010, wherein the energy level is used to differentiate between a original print or a copy of the original print. In order to different this there inherently has to be a threshold level set which defines an original print or a copy of the original print).

B.) Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads et al. (U.S. patent pub. 2004/0190751 A1) and Cass et al. (U.S. patent 5,946,414).

Regarding claim 3. The method wherein the image is a graphic.

Rhoads et al. discloses to embed a watermark into an image and based on energy levels determine if the watermarked image is an original printed image or a copy of the original printed image. Rhoads does not disclose wherein the image is a graphic. Cass et al. teaches to embed a watermark into a graphic image (Cass et al.; col. 3 lines 17-20 and col. 6 lines 42-47). It would have been obvious to one skilled in the art to combine the teaching of Cass et al. into the system of Rhoads et al. because they are analogous in watermarking. One in the art would have been motivated to incorporate the teaching of Cass et al. into the



system of Rhoads et al. in order to mark someone's artistic work wherein it can be identified as an original or counterfeit.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### **Contact Information**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anand Bhatnagar whose telephone number is

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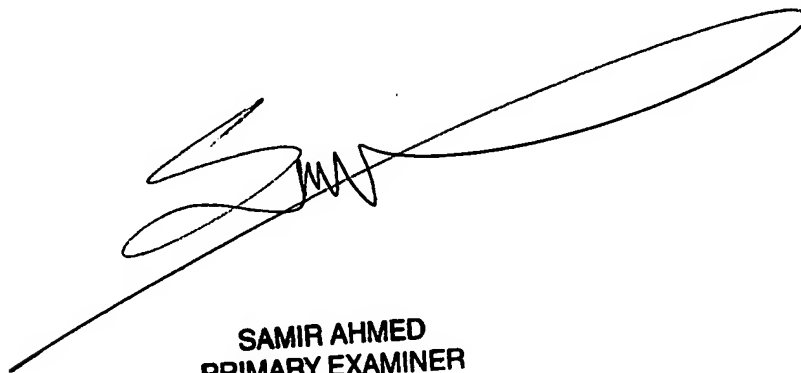
(703) 306-5914, whose supervisor is Amelia Au whose number is 703-308-6604, group fax is 703-872-9306, and Tech center 2600 customer service office number is 703-306-0377.

AB

Anand Bhatnagar

Art Unit 2623

July 25, 2005

A large, stylized handwritten signature in black ink, appearing to read 'SAMIR AHMED', is written over the printed name.

**SAMIR AHMED  
PRIMARY EXAMINER**